



APPENDIX.**Petitioner's Specific Replies to Respondent's "Counter-Statement of Facts" (Br. pp. 1-8).**

Respondent charges that "the essential facts of the case are considerably obscured and distorted in the petition" and purports to give "a more accurate and informative statement" (Br. p. 1). The converse is true. This will be demonstrated below by quoting respondent's principal misstatements and referring in connection with each thereof to the record.

I.

Respondent's statement (Br. p. 2): "These burrs and sharp edges [of expanded metal] are no different, however, from those produced by the shearing of any metal sheet or the like (Rec. pp. 77, 921-2)".

The Court of Appeals found: ".... the burrs and sharp edges which it was desirable to remove, *do not lie in the surface planes of expanded metal*," but between those planes and *within the diamonds* which constitute the mesh work" (Rec. p. 2991).

The president of respondent's predecessor wrote: "I have caused investigation to be made of using wire brushes to whip the material under high speed and endeavor to round those edges. That did not work for various reasons, *principally due to the peculiarity of the material itself and the shape of the mesh*" (Rec. p. 1973).

II.

Respondent's statement (Br. p. 2): "Actually, the brushes are applied in the only conceivable way of ap-

*Emphasis in quotations ours throughout Appendix.

plying them, that is, by bringing them to bear against the meshwork sheets with sufficient pressure to accomplish the desired result". Respondent cites no authority for this statement.

Petitioner's expert Sessions, under cross-examination by respondent's counsel, testified:

"Q. And from the standpoint of the action upon metal the brushes with which you are familiar as having been used in the art acted the same as the brushes used in the patent in suit?

"A. No, I think not. There is an action here in the brushing of these diamonds which calls upon the sides of the brushes away from the point, sides of the bristles away from the point to engage the sides of the diamonds and wipe or slice those edges of the diamonds which would not be touched by the ends of the bristles, such as in the brushing of a flat plate with a perfectly plain surface, there would be no difficulty in all of the ends of the bristles striking the plate.

"Q. Yes, but that is by virtue of the fact, is it not, Mr. Sessions, that we happen to have a particular type of material here that happens to have a particular form of opening in it? The action of the brush, however, in the case of the old uses to which you have referred and the new uses here which is alleged to be new, in so far as contact and removal of metal is concerned, broadly speaking, would be the same?

"A. No; no, I don't agree with you there, Mr. Olson. *These bristles, the sides of the bristles back of the point have a function in deburring this diamond machine [mesh], a function which they do not have in brushing any other materials with which I have been familiar*" (Rec. pp. 92-3).

III.

Respondent's statement (Br. p. 3): "Its [petitioner's] expert also admitted that the Cross patent lies in the old scratch brushing art" (Rec. p. 107).

Nothing could be farther from the truth. Petitioner's expert testified that machines for brushing imperforate metal sheets which he had been discussing earlier in his testimony were in the old scratch brushing art. His exact testimony, referring to his earlier testimony, was, "*The art which was under discussion was the old art of scratch brushing the surface of sheet metal*" (Rec. p. 107).

IV.

Respondent's statement (Br. p. 3): "The suitability of wire brushes for treating material having irregular surfaces is a matter of common knowledge", referring to Broderick patent 869,478 (Rec. p. 2445).

Not only is this statement anything but complimentary to the Buckman patents, "concededly the most pertinent references" (Rec. p. 2992), but it is belied by the Broderick patent itself. See Figure 2 (Rec. p. 2442), from which it is manifest that only flat sheets can be treated (they must lie between the brush 24 and the conveyor 17). The portion of the specification of Broderick quoted at the bottom of page 3 of respondent's brief manifestly refers only to minute irregularities in the flat sheets. Moreover, *scouring* or *burnishing* of flat sheets is a far cry from removal of burrs and sharp edges from expanded metal.

V.

Respondent's statement (Br. p. 4): "Contrary to petitioner's contentions, the [American Brass Co.] machines were adjusted and operated for these tests in a

perfectly normal manner", referring to what respondent calls "*inter partes tests*" (Br. p. 4), which were in fact tests conducted *solely* under respondent's supervision according to respondent's carefully prepared directions (Rec. pp. 847, 917).

The fact is that both the Buffalo machine and the Ansonia machine of American Brass Co. were operated during the tests in most unorthodox fashion. The leveling rollers, which were for the purpose of loosening scale on copper slabs, were retracted prior to the tests "so that there was nothing to guide the material [expanded metal] in and hold it at its proper rate of travel; after it hit this brush it jumped forward, so that that portion of the metal was not brushed by this brush" (Rec. p. 1867).

Also, the backing up rollers for the brushes "were very bright indeed" on the day of the test at Buffalo, "whereas when I had examined them in Buffalo on March 8th, they were dull and dirty, indicating they had not been in contact with the brushes. And I also noticed that there were a growing number of digs, scratches and deep digs in the surfaces of these rolls" (Rec. pp. 1867-8).

In the American Brass Co. machines the "backing up roll under the brushes is in such a position that it destroys the efficiency of the brush" (Rec. p. 1929).

Other evidence as to abnormal operation of the American Brass Co. machines during the tests run by respondent appears at pages 1864-75 and 1927-30 of the record. Even the designer of the machine testified at Ansonia, when questioned as to why the unusual procedure of the tests was followed, "I do not know; I was directed to do so" (Rec. p. 937).

VI.

Respondent's contention at the middle of page 4 of its brief that burrs and sharp edges on sheared metal sheets passed through the American Brass Co. machines in normal use "were satisfactorily removed by the brushes" is refuted by an eye witness who observed that the shear fin was "still present after the pieces had gone through the brushing machine" although bent "More nearly into the plane of the slab" by the levelling rolls (Rec. p. 1865), which were retracted and rendered inoperative when respondent ran its tests on expanded metal*.

Thus it is evident that the American Brass Co. machines taught nothing pointing the way to the Cross invention; quite the contrary, the Cross invention was used as the basis for respondent's "tests" wherein expanded metal was for the first and only time run through those machines (Rec. pp. 834, 938).

VII.

Respondent's statement (Br. p. 6): "Any significance to the allegations that the brushed product eliminated serious conditions of injury to workmen, etc., is negatived by the fact that there is no substantial evidence of such conditions ever existing".

The record:

(A) As to the existence of the problem:

The Master's report states:

"The evidence is convincing, in fact, there is no dispute, but that for some time before Cross perfected his brushing machine, *there had been much objection in the expanded metal industry to the*

**Supra*, p. 18.

sharp edges and burrs resulting from the processes of making such expanded metal, which is sheared from plain metal sheets." (Rec. p. 2850)

Witnesses of both parties testified to the defects of the old material. The first quotation is from the testimony of defendant's employee Hoffman; the other witnesses were all unbiased users:

"Well, there is no denying that sharp edges have *always* been present on expanded metal or any cut or sheared piece of sheet metal, and naturally that was present on expanded metal to a more or less degree, and *I have known it always*. Some of it is real sharp, and some of it is not. I do know that by care in setting up the knives when they are first sharpened, there is a very small fin edge, *sharp*, on expanded metal; when the knives get dull or when care is not used in the set up, the fin is larger and more pronounced." (Rec. p. 588)

"We had the same trouble as I think every one else had with expanded metal, of fins or wire edge on the expanded metal, which would cause lacerations, objected to very strongly by people that we would want to make guards for. It was used as a strong argument by the woven wire people, saying 'Use woven wire so as not to have that rough edge.' * * * It [the sharp edges] was a point of criticism always." (Rec. pp. 588-9)

"[Workmen would] come in with their hands cut,—especially when they'd stick their hands in between the expanded metal. * * * After a while, I got hooks made for the men to carry it by—hooks about two foot long and hooped on top." (Rec. p. 441)

"* * * hellish stuff to handle. The men were continually cutting their fingers and hands on it. * * * Proctor * * * cut his finger on this expanded

metal. * * * He did not come in for first aid treatment, and he stayed home for a day or two, and this cut that he had got developed blood poisoning and he went to the hospital and died in a few days." (Rec. pp. 410-1)

"* * * we had considerable trouble with the men being cut in handling that expanded metal, and it got so bad at one time that our safety engineer instructed us to compel the men to wear gloves * * *. We had one fatal accident that was traced to the expanded metal." (Rec. p. 421)

"* * * expanded steel would be basically ideal for our purposes, but we found that the first expanded metal we purchased involved danger to the workmen in handling the metal because of the sharp fins on the strands, or the perimeters, or whatever you call them, and necessitated their using gloves, but that in itself was not a cure for it, and while we were very anxious to have this class of metal available in preference to the material we had formerly purchased — that is, woven wire — we subsequently found that we could not use it generally, and its use caused us trouble and for that reason we were virtually forced to forget about the material in its application to our products." (Rec. p. 432)

"* * * we used it [the old expanded metal] for fabricating and it went on for a little while and then the men complained about cutting their hands in handling the mesh * * * and finally got to the point where they absolutely refused, * * * we discontinued using it in our shop." (Rec. p. 249)

Respondent's predecessor advised Underwriters' Laboratories "that it is impossible to entirely eliminate these small burrs and sharp edges" (Rec. p. 1963) and

"It is impossible, however, to make any expanded metal that will not have something of a sharp edge". (Rec. p. 1964). The Underwriters' Laboratories reported, "Sharp edges and burrs were found on all the labelled product." (Rec. p. 1968)

The Master's report states:

"That for many years there had been an insistent demand for such metal without the sharp edges is very clear from the evidence." (Rec. p. 2850) "The evidence shows that long before the Cross application date there had been an insistent demand for expanded metal which was free from burrs and sharp edges." (Rec. p. 2882)

"And in fact this record is replete with evidence introduced in behalf of both parties which is convincing that long before Cross many others had considered such smooth edged fabric as a desirable product, and had made various efforts to make it." (Rec. p. 2844)

(B) As to the solution:

"* * * we eliminate those hazards to the workmen * * * deburred expanded metal may be easily handled, readily handled, without the hazardous or dangerous effect." (Rec. p. 186)

"* * * the removal of the sharp fins on the strands has opened up the field anew for us * * * it permits us to compete with the woven wire manufacturers * * *." (Rec. p. 433)

"* * * we are using it ["SAFE-T-MESH"] for certain definite purposes now, that it would be absolutely impossible to use it in its prior state before the new process." (Rec. p. 251)

*Petitioner's trade-mark for its deburred expanded metal.

"* * * we can go out to a customer with this material and guarantee him a good smooth finished job, where we could not with the old material." (Rec. p. 416)

"I do get jobs now with the Safe-T-Mesh which I couldn't get before." (Rec. p. 445)

"* * * that ["SAFE-T-MESH"] was, well, as near smooth as you could want anything; and tickled to death we were when we first got that." (Rec. p. 441)

The District Judge held: "The Cross patent was the solution and the response to that objection and demand." (Rec. p. 2927)

VIII.

Respondent's statement (Br. p. 6): "Its [petitioner's] vice-president testified that petitioner never had any complaints that the unbrushed material did not come up to the claims of its literature alleging a high degree of smoothness of that material."

The record: "Q. Did you ever have any complaints from your customers about sharp edges on the expanded metal?

"A. We had innumerable complaints. I have had many of them tell me, 'Can't you do something to eliminate these burrs, these sharp edges, and so forth?'" (Rec. p. 214)

IX.

Respondent's contention (Br. p. 7) that the disclaiming of claim 15 of the Cross patent by petitioner shows "the speciousness of the 'insistent demand' argument" is a *non sequitur*.

Claim 15 was disclaimed because the Master found that it "should be held to be invalid because the evidence shows that *samples* were regularly *filed* to make them smooth" (Rec. p. 2888). This was a tedious hand operation applicable *only* to *samples* and, even so, did not remove the burrs and sharp edges in the sharp crotches of the diamonds (Rec. p. 1670). The insistent demand existed* and the disclaiming of claim 15 is certainly no admission to the contrary.

**Supra*, pp. 19-22.

